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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,138

11/25/2003

Kevin Li

NC34682

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4955

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07/13/2006

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EXAMINER

ADDY, ANTHONY S

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/723,138

Applicant(s)

LI, KEVIN

Examiner

Anthony S. Addy

Art Unit

2617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Attachment (Response to Arguments).
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.



Examiner: Anthony S. Addy
Phone: (571) 272-7795

ADVISORY ACTION

Response to Arguments

Applicant's arguments filed on June 12, 2006 have been fully considered but they are not persuasive.

With respect to applicant's argument that, "Yoshida fails to disclose or suggest a system that effectuates receive diversity" by arguing that, "simply because a cellular phone can operate in multiple bands does not mean that the cellular phone can effectuate receive diversity reception, and that a multiband cellular phone is able to roam between different operating frequencies dependent upon operator networks or the geographic location of the device, but the multiband cellular phone disclosed by Yoshida is incapable of effectuating receive diversity because the phone does not contain a second antenna that facilitates reception of signals in one band and at least one of the bands received by the first antenna, wherein the second antenna is tuned depending on the signal type relayed to the second antenna (see page 2, third paragraph of the response)," examiner respectfully disagrees and maintains that Yoshida in view of Standke meets the limitations as claimed. Examiner reiterates that Yoshida teaches a cellular phone (i.e. a mobile communication device) has a multiple-band receiver and a multiple-band transmitter, wherein the multiple-band receiver can receive, for example, 900 MHZ and 1.8 GHz radio frequency signals, among others (see p. 2 [0025]). Yoshida further teaches the multi-band transmitter and receiver may include single band, dual band, tri-band and additional band capability and the multi-band transmitter can transmit 900 MHZ and 1.8 GHz radio frequency signals (see p. 2

[0025]). Thus it is substantially clear the teachings of Yoshida meets the limitation of “a system that effectuates received diversity within a mobile communication device” since Yoshida teaches a cellular phone including a multiple-band receiver and a multiple-band transmitter, wherein the multiple-band receiver and transmitter can receive and transmit, for example, 900 MHZ and 1.8 GHz radio frequency signals, among others.


In response to applicant's arguments that, the recitation “receive diversity” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Furthermore, with respect to applicant's argument that the cited references fail to disclose or suggest, alone or in combination a second antenna that facilitates reception of signals in a GPS band and at least one of the bands received by the first antenna, wherein tuning of the second antenna depends upon a signal type relayed to the second antenna (see page 3, third paragraph of the response),” examiner respectfully disagrees and maintains that Yoshida in view of Standke meets the limitations as claimed. Examiner reiterates that Standke teaches a multiple band wireless telephone with multiple antennas, wherein an external antenna is tuned for a multi-band response to access both telephone and GPS signals (see col. 1, lines 38-41) and an internal

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antenna is tuned to receive GPS and Bluetooth signals (see col. 1, lines 41-45 and col. 2, lines 23-37) which in combination with the teachings of Yoshida broadly meets the limitations as claimed.

Additionally, in response to applicant's argument that "Examiner has failed to establish a prima facie case of obviousness," the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of Yoshida and Standke provide adequate motivation as taught for example by Standke (see *Standke*, col. 1, line 64 through col. 2, line 3). Furthermore it appears applicant is arguing against the references individually, however it has been held that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).


ELISEO RAMOS-FELICIANO
PRIMARY EXAMINER 7/10/06